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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/065,672	04/23/1998	PATRICIA A. BILLING-MEDEL	6086.US.P1	7811

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EXAMINER

TURNER, SHARON L

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 07/29/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/065,672

Applicant(s)  
Billing-Medel

Examiner  
Sharon L. Turner, Ph.D.

Art Unit  
1647



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5-10-02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 54-68 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 54-68 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-18-02 has been entered.
2. Claims 22-53 are canceled. New claims 54-68 are pending.

**Improper Markush**

3. Prior to setting forth the restriction requirement, it is pointed out that applicants have presented instant claims in improper Markush format, see Ex parte Markush, 1925 C.D. 126, In re Weber, 198 USPQ 334 and MPEP 803.02 and 806.04. The claims are improperly set forth as the genus claims encompassing multiple products, as identified and claimed, fail to share the characteristics of a genus, i.e., a common utility and a substantial structural feature essential to the disclosed utility. Alternatively, the claims define multiple structurally distinct compounds capable of different use, with different modes of operation, different function and different effects. A reference against one of the claimed components or methods would not be a reference against the other. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because the claims define inventions which are not proper species.

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***Election/Restriction***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 54-66 in part drawn to nucleic acids, classified for example in class 536, subclass 23.1.
  - II. Claims 67-68 in part drawn to polypeptides, classified for example in class 530, subclasses 300 and 350.
5. The inventions are distinct, each from the other because of the following reasons:
6. Inventions I and II are related as products. The products are distinct each from the other as the products are comprised of divergent structure, effects and function, for example nucleic acids and polypeptides.
7. Furthermore, in addition to the election of one of the above VIII groups, further restriction is required under 35 U.S.C. 121 as set forth below to delineate the molecular embodiments to which the claims will be restricted in accordance with the elected group:
  - A) A single designated nucleic acid composition selected from SEQ ID Nos: 1, 3, 4, 5, residues 4-269 of SEQ ID NO:2, residues 10-214 of SEQ ID NO:3, residues 1-276 of SEQ ID NO:4, residues 1-276 of SEQ ID NO:5, nucleic acids encoding residues 1-55 of SEQ ID NO:12, nucleic acids encoding SEQ ID NO:13 and nucleic acids encoding SEQ ID NO:14.
  - B) A single polypeptide selected from residues 1-55 of SEQ ID NO:12, SEQ ID NO:13 and SEQ ID NO:14.
8. The inventions are distinct, each from the other because of the following reasons:

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9. Although there are no provisions under the section for “Relationship of Inventions” in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because the products indicated as A-B constitute patentably distinct inventions for the following reasons. Each of the polynucleotides and polypeptides has a unique structural feature which requires a unique search of the prior art. The inventions indicated in A-B differ in structure and function as they are composed of divergent nucleic and amino acids and are differentially able to hybridize, bind or mediate biological functions. A reference to one element would not constitute a reference to another. In addition, searching all of the molecules in a single patent application would provide an undue search burden on the examiner and the USPTO’s resources because the indicated searches are not co-extensive.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

11. Because these inventions are distinct for the reasons given above and the search required for any Group is not required for any other Group, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated groups I-II and a single molecular embodiment from those designated in groups A and B to which the claims will be restricted, even though the requirement is traversed. Applicant is advised that neither I-II nor A-B are species election requirements; rather each of I-II and A-B are restriction requirements. The subject matter for examination will be restricted to the extent of the subject matter of the elected groups.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

15. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

A handwritten signature in black ink, appearing to read "Sharon L. Turner". The signature is fluid and cursive, with the first name "Sharon" being more prominent than the last name "Turner".

Sharon L. Turner, Ph.D.  
July 22, 2002